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TRANSMITTAL OF APPEAL BRIEF (Large Entity)

Docket No.
BKA.0011US

In Re Application Of: **Jonathan D. Lowthert and Oleg B. Rashkovskiy**

| Application No. | Filing Date | Examiner | Customer No. | Group Art Unit | Confirmation No. |
|-----------------|------------------|------------|--------------|----------------|------------------|
| 09/766,133 | January 19, 2001 | Usha Raman | 21906 | 2623 | 9485 |

Invention: **Content with Advertisement Information Segment**

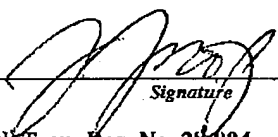
COMMISSIONER FOR PATENTS:

Transmitted herewith is the Appeal Brief in this application, with respect to the Notice of Appeal filed on:
April 8, 2008

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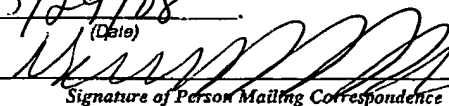

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Dated: 5/28/2008

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THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Applicant:

Jonathan E. Lowthert, et al.

Serial No.: 09/766,133

Filed: January 19, 2001

For: Content with Advertisement
Information Segment

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Art Unit: 2623

Examiner: Usha Raman

Atty Docket: BKA.0011US

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APPEAL BRIEF

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Nancy Meshkoff

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REAL PARTY IN INTEREST

The real party in interest is the assignee BlackArrow, Inc.

RELATED APPEALS AND INTERFERENCES

Appeals relating to this appeal are as follows:

- In Application No. 09/560,458 (now U.S. Patent No. 6,912,504) a decision on appeal was mailed for Appeal No. 2004-0992 on September 23, 2004.
- In Application No. 09/690,549, a decision on appeal was rendered for Appeal No. 2007-0721 on March 7, 2008.

STATUS OF CLAIMS

Claims 1-26 (Canceled).

Claim 27 (Provisionally rejected, double patenting).

Claims 27-38 (Rejected).

Claims 39-40 (Canceled).

Claims 27-38 are rejected and are the subject of this Appeal Brief. The provisional double patenting rejection is not appealed at this time.

STATUS OF AMENDMENTS

No reply was submitted to the Final Rejection mailed on March 17, 2008. All amendments have therefore been entered.

SUMMARY OF CLAIMED SUBJECT MATTER

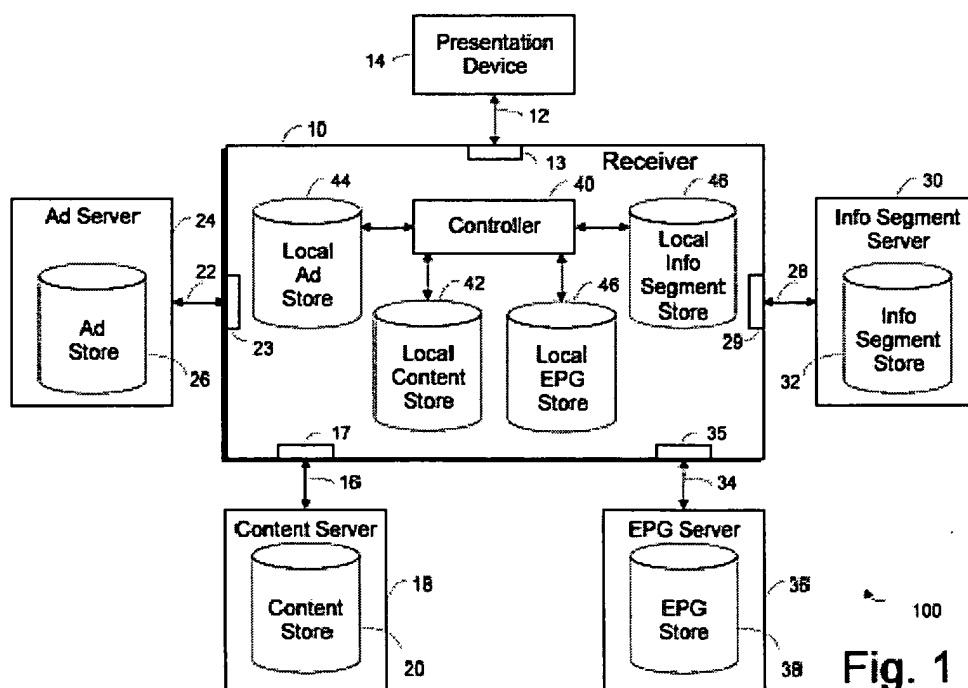
In the following discussion, the independent claim is read on one of many possible embodiments without limiting the claims:

27. A system comprising:

a receiver to receive a contiguous block of a content data stream with an information segment and a plurality of advertisements (Figure 1 at 10, Specification at page 3, line 29-page 5, line 6), said information segment having at least one ad entry, said ad entry having a field in the form of an interruption point specifier to indicate a point within said contiguous block (Specification at page 7, line 29) of content data stream to interrupt the play of said content data stream and to insert an advertisement in said content data stream for play prior to the resumption of the play of the content data stream (Specification at page 5, line 10);

a cache, coupled to said receiver, to store said content data stream with said information segment and said plurality of advertisements (Figure 1 at 42, 44, 46; Specification at page 4, lines 25-31); and

an interface, in said receiver, to identify a content data stream location and an advertisement, out of said plurality of advertisements, to insert in said location, said interface to identify, based on data from the interruption point specifier, said location while said content data stream is still stored in said cache (Figure 1 at 40, Specification at page 6, lines 3-20).



At this point, no issue has been raised that would suggest that the words in the claims have any meaning other than their ordinary meanings. Nothing in this section should be taken as an indication that any claim term has a meaning other than its ordinary meaning.

GROUND OF REJECTION TO BE REVIEWED ON APPEAL

- A. Whether claims 27-30, 34-35, and 37-38 are anticipated under 35 U.S.C. § 102(e) by Knepper (US 2001/0042249).**
- B. Whether claim 31 is unpatentable under 35 U.S.C. § 103(a) over Knepper (US 2001/0042249) in view of Schoff (US 6,240,555).**
- C. Whether claims 32 and 35-36 are unpatentable under 35 U.S.C. § 103(a) over Knepper (US 2001/0042249).**
- D. Whether claim 33 is unpatentable under 35 U.S.C. § 103(a) over Knepper (US 2001/0042249) in view of Yiu (US 6,008,777).**

ARGUMENT

A. Are claims 27-30, 34-35, and 37-38 anticipated under 35 U.S.C. § 102(e) by Knepper (US 2001/0042249)?

Claim 27 specifies that the content that is received is a contiguous block of content in the form of a data stream. As claimed, there is a data stream that is contiguous and, nonetheless, advertisements are inserted therein.

This is very different than what happens in Knepper. In Knepper there are discrete files and the advertisements are simply put between discrete files. The system provides a sequence of content files and advertisement files and the client simply puts together the files (that are distinct) in the specified sequence. No advertisement is inserted within any discrete media or content file. Obviously, the Knepper approach is a more limited solution than what is claimed.

The way that Knepper works is best shown in Figure 4 where there is a series of show clips with ads. For example, there are three groups of show clips that are sequentially played. The show clips are 303 and their ads are 305. Show clip 1 is played, then the ad 305, then show clip 2 is played, then the next ad, then show clip 3, then the next ad. There is no way to insert the ad inside any piece of content that is a discrete file.

A text file gives the sequence of media and ad files are a listing of the order of the entertainment advertisement media files that will make up the show. See paragraph 34. The client application assembles the entertainment advertisement media files and begins playback of the various files in the order specified by the instruction set. See paragraph 37. As shown in Figure 4, the show clips 301 each comprise an entertainment media file 303 and an advertisement media file 305. See paragraph 38. The assembled clip comprising both the entertainment media files 303 and the advertisement media files 305 then plays within a page 307. While a fully assembled show clip preferably consists of separate media files, such as the entertainment media file 303 and an advertisement media file 305, it proceeds through playback within a single page 307. See paragraph 38. The media files play together sequentially. See paragraph 41. While the advertisement files are inserted between successive media files, there is no insertion of advertisements inside one discrete media file.

Thus, claim 27 distinguishes because it calls for inserting the advertisements within a data stream and within a contiguous block of content data stream. This is completely the

opposite of what is done in Knepper, which specifically provides a way of playing media files from the Internet "without employing traditional streaming methods." See paragraph 8 [emphasis added].

Thus, Knepper does not teach inserting the advertisement inside a media file and he teaches no way to insert an ad into a contiguous content data stream.

Therefore, the rejection should be reversed.

B. Is claim 31 unpatentable under 35 U.S.C. § 103(a) over Knepper (US 2001/0042249) in view of Schoff (US 6,240,555)?

For the reasons set forth in section A, this rejection should be reversed.

C. Are claims 32 and 35-36 unpatentable under 35 U.S.C. § 103(a) over Knepper (US 2001/0042249)?

For the reasons set forth in section A, this rejection should be reversed.

D. Is claim 33 unpatentable under 35 U.S.C. § 103(a) over Knepper (US 2001/0042249) in view of Yiu (US 6,008,777)?

For the reasons set forth in section A, this rejection should be reversed.

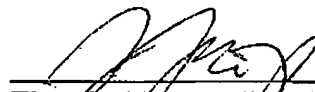
* * *

Applicant respectfully requests that each of the final rejections be reversed and that the claims subject to this Appeal be allowed to issue.

Respectfully submitted,

Date: _____

5/28/2008



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CLAIMS APPENDIX

The claims on appeal are:

27. A system comprising:
- a receiver to receive a contiguous block of a content data stream with an information segment and a plurality of advertisements, said information segment having at least one ad entry, said ad entry having a field in the form of an interruption point specifier to indicate a point within said contiguous block of content data stream to interrupt the play of said content data stream and to insert an advertisement in said content data stream for play prior to the resumption of the play of the content data stream;
 - a cache, coupled to said receiver, to store said content data stream with said information segment and said plurality of advertisements; and
 - an interface, in said receiver, to identify a content data stream location and an advertisement, out of said plurality of advertisements, to insert in said location, said interface to identify, based on data from the interruption point specifier, said location while said content data stream is still stored in said cache.
28. The system of claim 27 wherein said interface to utilize a content identifier to associate said information segment with said content data stream.
29. The system of claim 27 wherein said interface to utilize an info segment having a plurality of fields, one field comprising said interruption point specifier, another field selected from the group consisting of a maximum interruption length specifier, a resume indicator, a permitted ad type specifier, a prohibited ad type specifier, and an ad lock.
30. The system of claim 29 wherein said ad entry includes said plurality of fields, said interface to use data from said fields to control the relationship between the content data stream and said plurality of advertisements.

31. The system of claim 27 wherein said cache stores an electronic programming guide having a program identifier and an associated info segment, said electronic programming guide to enable locating the info segment corresponding to a selected program.

32. The system of claim 27 wherein said system is a television receiver.

33. The system of claim 27 wherein said system is connected to a presentation device through a wireless connection.

34. The system of claim 27 wherein said location is where the sound volume goes to zero.

35. The system of claim 28 wherein said content identifier is a hashed value of a closed caption text.

36. The system of claim 28 wherein said content identifier is a VCR plus number.

37. The system of claim 29 wherein said resume indicator to indicate if a user can override the insertion of an advertisement.

38. The system of claim 37 wherein said system detects the activation of a button on a remote control unit to override the insertion of an advertisement.

EVIDENCE APPENDIX

None.

RELATED PROCEEDINGS APPENDIX

See, on the following pages:

- Decision on Appeal No. 2004-0992, mailed September 23, 2004, in Application No. 09/560,458 (now U.S. Patent No. 6,912,504).
- Decision Appeal No. 2007-0721, decided March 7, 2008, in Application No. 09/690,549.

PIL

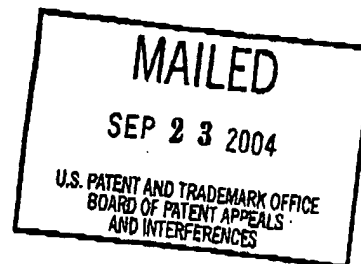
The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 18

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCESEx parte OLEG B. RASHKOVSKIYAppeal No. 2004-0992
Application No. 09/560,458

ON BRIEF



Before KRASS, RUGGIERO and BLANKENSHIP, Administrative Patent Judges.

KRASS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the final rejection of claims 2-7 and 9-26.

The invention pertains to the distribution of television advertisements over the Internet.

Mail Date _____
Due Date _____
Act. Req. _____

TPHD ☒TPHA ☐ITLD ☐

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Application No. 09/560,458

Representative independent claim 15 is reproduced as follows:

15. A method comprising:

determining whether a client is configured to automatically display adverting material in association with other content; and
providing through a server access to the other content.

The examiner relies on the following reference:

Hidary et al. (Hidary) 5,774,664 Jun. 30, 1998

Claims 2-7 and 9-26 stand rejected under 35 U.S.C. 103 as unpatentable over Hidary.

Reference is made to the briefs and answer for the respective positions of appellant and the examiner..

OPINION

At the outset, we note that contrary to appellant's indication, there is no issue before us involving a rejection under 35 U.S.C. 102. The sole issue before us on appeal is the obviousness of the claimed subject matter under 35 U.S.C. 103.

It is the examiner's position, with regard to claims 2-4, 6, 7 and 9-14, that Hidary discloses detecting an event comprising comparing the time of day, which reads on the current time, to the time that advertising is to be distributed (column 3, lines 47-49); viewing an advertisement distributed over a TV

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Application No. 09/560,458

distribution system (column 2, lines 37-38), which reads on automatically accessing an advertisement distributed over a first medium; accessing content over the Internet, which reads on a second medium, and displaying the advertisement in association with the content from the second medium (column 3, lines 45-49).

The examiner indicates that Hidary does not teach interrupting the content to display the advertisement and does not teach inserting advertising material. However, the examiner alleges that this is the "common mode" (answer-page 4) for combining advertising with content in commercial television broadcasting. Accordingly, the examiner concludes that it would have been obvious to interrupt the content to display the advertising.

With regard to claim 5, the examiner alleges that Hidary teaches accessing the advertisement at a certain period of time (column 5, line 66 through column 6, line 3) and that this reads on accessing the advertisement in response to an elapsed period of time.

With regard to claims 15-26, the examiner alleges that Hidary teaches providing through a server 28 access to other content (column 5, lines 39-44) and automatically displaying

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advertising material with the content (column 2, lines 34-35 and column 3, lines 34-36).

While the examiner indicates that Hidary does not explicitly teach determining whether a client is configured to automatically display advertising material in association with other content, the examiner contends that Hidary "necessarily" performs the method claim and that, therefore, Hidary inherently discloses the claimed subject matter (see page 5 of the answer). In order to show the inherency alleged, the examiner notes that it is necessary to determine whether a client is configured to automatically display advertising material in association with other content before the advertising material is automatically displayed in association with other content. The examiner indicates that the reference teaches, at column 3, lines 37-40, that any standard PC is physically configured to implement the reference invention, and that information is provided regarding when the advertising material is to be distributed over the first medium, at column 3, lines 45-49.

With regard to claims 2-7 and 9-14, appellant argues that Hidary does not interrupt content accessed from one medium to display an advertisement that is accessed and distributed over a

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different medium and that there is no motivation for modifying Hidary to provide for such.

We agree with appellant.

Each of claims 2-7 and 9-14 requires accessing an advertisement distributed over a first medium, accessing content from a second medium and interrupting the content and displaying the advertisement. It is clear that Hidary does disclose two mediums, a TV broadcast, and the Internet, whereby content is accessed from one medium and advertisements are accessed from the other medium. But, Hidary displays the content simultaneously with the advertisement material, rather than interrupting the content and displaying the advertisement.

The examiner recognizes this deficiency in Hidary but contends that it would have been obvious to display the advertisement by interrupting the content in view of the old and well known technique, in broadcast TV, of interrupting the content of a television program by commercials, i.e., advertisements.

We agree that it was well known, in commercial TV, to interrupt program content for permitting advertisements. However, in such cases, the advertisement and the program content both emanate from the same medium, rather than two different

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mediums, as required by the instant claims. It is true that Hidary shows two different mediums for presenting the content and the advertisement, but there does not appear to be any reason for the artisan to have modified Hidary to provide for an interruption of the content in order to display the advertisement.

Hidary recognized the old broadcast TV method of interrupting programs to display advertisements. This is apparent throughout Hidary's disclosure as, for example, at column 2, lines 62-64, wherein it is disclosed that

advertisers can speak more directly to consumers by directly sending Web pages to the consumer instead of only displaying Web addresses in their commercials; and consumers can gain a new level of interest and interactivity over a video-based medium.

Thus, it is clear that Hidary wants to get away from the mere watching of TV commercials which interrupt regular broadcast TV programs and wants to involve viewers interactively. This is why Hidary provides for simultaneous display of content and advertisement. Accordingly, it would appear contrary to Hidary's teachings to merely interrupt a broadcast TV program with the display of an advertisement, rather than the simultaneous display of both. Accordingly, we find that the skilled artisan would not have been led to modify Hidary in such a way to interrupt the

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broadcast TV program content in order to provide for an advertisement from a different medium. The display of an advertisement alongside content is not an "interruption" of the content, as required by the instant claims.

Therefore, we will not sustain the rejection of claims 2-7 and 9-14 under 35 U.S.C. 103.

We reach the opposite result with regard to claims 15-26 and we will sustain the rejection of claims 15-26 under 35 U.S.C. 103.

With regard to claims 15-26, appellant argues that the examiner relies on inherency for the rejection of these claims. This is true. The examiner does find it inherent in Hiday to determine whether a client is configured to automatically display advertising material in association with other content. The examiner explains that it is necessary to determine whether a client is configured to automatically display advertising material in association with other content before the advertising material is automatically displayed in association with other content.

Appellant does not argue, in any meaningful way, the merits of the examiner's position that in order to automatically display advertising material, a client must, of necessity, be configured

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to display such material. Instead, appellant argues that the examiner's inherency argument points to a rejection under 35 U.S.C. 102, rather than a rejection under 35 U.S.C. 103 (see page 7 of the reply brief).

This argument is not persuasive because even if the examiner could have made the rejection under 35 U.S.C. 102, rather than under 35 U.S.C. 103, anticipation is the epitome of obviousness. In re Fracalossi, 681 F.2d 792, 215 USPQ 569 (CCPA 1982).

The examiner's position that in order for something to be displayed, a system must be configured to display it, is so reasonable to us that appellant must provide some reason why this would not be the case. Appellant's mere assertion, at page 8 of the reply brief, that the examiner has not shown that Hidary must function or perform in the claimed manner, does not, in our view, overcome the examiner's reasonable assertion of inherency, in view of the rather broad scope of the instant claims. For example, independent claim 15 merely requires a determination of whether a client is configured to automatically insert and display advertising material in association with other content; and providing through a server access to the other content. Clearly, Hidary provides access to content through the Internet via a server. Further, Hidary provides for the display of

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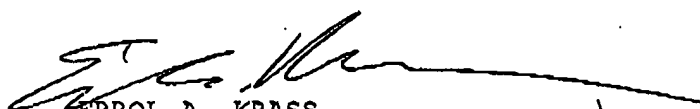
advertising material in association with the other content. If
Hidary displays advertising material in association with other
content, then the client performing this function must, of
necessity, be "configured" to do so.

We have sustained the rejection of claims 15-26 under
35 U.S.C. 103 but we have not sustained the rejection of claims
2-7 and 9-14 under 35 U.S.C. 103.


Accordingly, the examiner's decision is affirmed-in-part.

No time period for taking any subsequent action in
connection with this appeal may be extended under 37 CFR
§ 1.136(a).

AFFIRMED-IN-PART


ERROL A. KRASS
Administrative Patent Judge


JOSEPH F. RUGGIERO
Administrative Patent Judge


HOWARD B. BLANKENSHIP
Administrative Patent Judge

BOARD OF PATENT
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EK/RWK

Appeal No. 2004-0992
Application No. 09/560,458

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte OLEG B. RASHKOVSKIY

Appeal 2007-0721
Application 09/690,549
Technology Center 2600

Decided: March 7, 2008

Before JOHN C. MARTIN, LEE E. BARRETT, and ALLEN R. MACDONALD,
Administrative Patent Judges.

MARTIN, *Administrative Patent Judge.*

DECISION ON APPEAL
STATEMENT OF THE CASE

This is an appeal under 35 U.S.C. § 134(a) from the Examiner's rejections of claims 47-57, all of the pending claims, based on prior art. We have jurisdiction under 35 U.S.C. § 6(b).

We reverse.

A. Appellant's disclosure

This invention relates generally to systems used, for example, in a home to record audio or visual content including advertisements for subsequent replay and, more particularly, to such a system in which the stored advertisements are automatically updated in response to update instructions. Thus, each time the user replays the stored content he or she will see the most current advertisement (Specification 9:16-18). For example, a commercial from an automobile dealer advertising a Fourth of July sale would be replaced after that sale by a more current commercial (*id.* at 9:11-16).

The Specification applies the term “content,” which appears in the claims, collectively to programming and commercials: “In the course of receiving and compressing the content, a commercial may be identified within the content as indicated in block 54 (*id.* at 4:6-8).

The commercials and the other content may be recorded in different memories or in different parts of the same memory (*id.* at 5:9-11).

“When the commercial is recorded, a marker may be inserted into the ongoing content record in order to identify the location to insert a commercial” (*id.* at 5:14-16), which we understand to mean the marker identifies the location in which to insert a commercial during playback. “In addition, a pointer may be provided to indicate where the commercial has been stored, when the commercial is stored in a different storage or in a different storage area than the rest of the content” (*id.* at 5:16-20).

The “update instructions” may be acquired and stored at the same time that a commercial is first received or may be obtained thereafter (*id.* at 8:4-7).

The term “update instructions” is not defined in the Specification but appears to include an instruction indicating when to perform an updating operation. *See id.* at 6:20-23 (“For example, in accordance with one embodiment, at predetermined times, all of the stored commercials may be automatically updated in accordance with stored update instructions.”); *id.* at 8:6-11 (“In other embodiments, update instructions may thereafter be obtained. For example, by identifying a commercial using codes or keywords as two examples, a system may automatically determine from a database when the commercial should be updated.”).

The Specification distinguishes updated advertisements from entirely new replacement advertisements. *See id.* at 9:20-24 (“In some embodiments of the present invention, a stored advertisement may be replaced with an updated advertisement. However, in other embodiments, the stored advertisement may be replaced by another advertisement that does not constitute an update.”); *id.* at 10:15-19 (“In some cases, the replacing advertisements may be updates of existing advertisements. In other cases, the replacing advertisements may be totally new advertisements unrelated to the advertisements they replace.”).

B. The claims

The claims are directed to replacing previously recorded advertisements with updated advertisements. Claim 47, the sole independent claim, reads:¹

47. A system comprising:

a receiver to receive content, an advertisement and update instructions for said advertisement;

a cache, coupled to said receiver, to store said content and said advertisement; and

a shell, in said receiver, to find a place to insert the advertisement in the cached content before the cached content continues to be output for display, said receiver to receive an update for said advertisement and to automatically replace said advertisement with said update using said instructions.

C. The references and rejections

The references relied on by the Examiner and their issue dates are:

| | | |
|--------------------|--------------|---------------|
| Khoo et al. (Khoo) | US 6,434,747 | Aug. 13, 2002 |
| Rosser | US 6,466,261 | Sept. 3, 2002 |

Claims 47-50 and 55-57 stand rejected under 35 U.S.C. § 102(e) for anticipation by Rosser.

¹ Prior to filing the Brief, Appellant submitted a Reply to Final Rejection including proposed amendments of claims 47-49. The proposed amendments were denied entry in the January 27, 2006, Advisory Action Before the Filing of an Appeal Brief.

Claims 51-54 stand rejected under § 103(a) for obviousness over Rosser in view of Khoo.

THE ISSUES²

Has Appellant demonstrated that the Examiner erred in rejecting the claims for anticipation or obviousness?

PRINCIPLES OF LAW -- ANTICIPATION

Anticipation is a question of fact. *In re Schreiber*, 128 F.3d 1473, 1477 (Fed. Cir. 1997). “To anticipate a claim, a prior art reference must disclose every limitation of the claimed invention, either explicitly or inherently.” *Id.*

Claims will be given their broadest reasonable interpretation consistent with the specification and limitations appearing in the specification are not to be read into the claims. *In re Zletz*, 893 F.2d 319, 321-22 (Fed. Cir. 1989).

ANALYSIS

² Appellant has the burden on appeal to the Board to point out the errors in the Examiner’s position. *See In re Kahn*, 441 F.3d 977, 985-86 (Fed. Cir. 2006) (“On appeal to the Board, an applicant can overcome a rejection by showing insufficient evidence of *prima facie* obviousness or by rebutting the *prima facie* case with evidence of secondary indicia of nonobviousness.”) (quoting *In re Rouffet*, 149 F.3d 1350, 1355 (Fed. Cir. 1998)).

A. Rosser's disclosure

Rosser discloses a television system in which a viewer's set-top device can be used to insert, into the picture displayed on viewer's video screen, commercial advertising tailored to the viewer based on his or her viewing history, which is monitored by the set-top box.

In the Figure 1 system, the transmitter includes an LVIS (Live Video Insertion System) front end 16 for inserting extra information (e.g., advertising) into a standard video signal, such as by inserting the extra information into the vertical blanking signal or into a spare audio channel (col. 6, ll. 52-55). Specifically, an encoding unit 24 in LVIS front end 16 may insert into the video signal all or any of a graphic or video for insertion 26, a program category code 27, or one or more user profile and enabling keys 28 (col. 6., ll. 55-61). The inserted information may occupy a number of video fields (*id.*).

The set-top device 44 at the receiver includes a downstream LVIS system 46, a memory device 5, and a viewer profile 50. The set-top device 44 strips off, interprets, and uses any of a graphic or video, a user enabling key, one or more viewer usage profile keys 120, and a program category code that may have been attached to the video stream (col. 7, ll. 46-50). Based on a comparison of the viewer usage profile keys 120 with the local viewer usage profile 50, different insertions 58 and 60 may be made on different end users' video viewing devices 56 (col. 7, ll. 51-55). The different insertions may be permanently stored locally in memory device 55 or downloaded there during or prior to transmission of the live video transmission into which they are inserted for display (col. 7, ll. 55-58).

Figure 2 shows the details of a suitable set-top device 44. The device includes, *inter alia*, a vertical blanking interval decoder 80, which causes the various advertising video and text insertion candidates to be stored in video insertion circuit 90 and text data circuit 92. *See* column 10, lines 29-31 (“Profile matcher 96 also selects which of the stored video insertions 90 are fed to warp unit 100.”). The vertical blanking interval decoder 80 also extracts the “required viewer usage profiles” that correspond to each of the video and text insertion candidates (col. 10, ll. 18-20). The profile matcher 96 compares the viewer’s usage profile (74) with the received “required viewer usage profiles” in order to determine which of the stored video and/or data insertions is to be combined with the television signal in multiplexer 102, which is coupled to the viewer’s television set via a channel 3 modulator 104.

Figure 4 shows an alternative embodiment of the set-top device for receiving an input data stream 70 from any of internet/telephone 130, cable 132, broadcast 134, and satellite 136. The insertion video and data are stored, for example, in video/audio storage unit 152 (col. 13, ll. 13-33), which can take the form of a RAM (col. 11, ll. 1-10). Two modes of operation are described. In the first, advertising information is received as an alternate video feed from one of the inputs and stored in video/audio storage unit 152 (col. 13, ll. 13-18). More particularly,

[t]his alternate video feed would typically be relaying a number of different advertisements with a requested viewer usage profile or range of profiles suitably associated, attached to or encoded in, each particular advertising sequence. The contents of the alternative feed may be stored in video and audio storage unit 152. At the appropriate time and place for advertising insertion, which may be, but is not limited to, a conventional advertising break, or when the viewer

changes channel, or when a particular image or scene is in view, the central controller will use video and audio router 150 and data router 152 and whichever is necessary of the other video and audio function modules, including but not limited to, video and audio storage device 152, to place an appropriate advertisement on the end user's viewing device 106. The appropriate advertisement on any given set top device would be the one where the local viewer usage profile matches or falls within the parameters of the required viewer usage profile attached to the advertisement.

Col. 13, ll. 18-37.

In the second mode of operation, the set-top device functions as a downstream LVIS system and thus like the Figure 2 embodiment. The interpreter 146 extracts advertising information from the vertical blanking interval of the television signal and data store 168 stores the advertising information for later insertion into the displayed television signal (col. 14, ll. 26-47).

B. Whether Rosser discloses a “cache . . . to store said content and said advertisement”

While, as noted above, the Specification applies the term “content” collectively to programming and commercials, it is evident from claim 47 as a whole that the term “content” as used therein refers to content other than advertisements (e.g., to a television program). As explained in *Phillips v. AWH Corp.*, 415 F.3d 1303, 1314 (Fed. Cir. 2005):

Quite apart from the written description and the prosecution history, the claims themselves provide substantial guidance as to the meaning of particular claim terms. *See Vitronics [Corp. v. Conceptronic, Inc.]*, 90 F.3d [1576 (Fed. Cir. 1996)] at 1582; *see also ACTV, Inc. v. Walt Disney Co.*, 346 F.3d 1082, 1088 (Fed. Cir. 2003) (“the context of the

surrounding words of the claim also must be considered in determining the ordinary and customary meaning of those terms”).

In response to Appellant’s argument that Rosser fails to disclose a cache that stores “content” as well as advertising, the Examiner contends that claim 47’s recitation of “a cache . . . to store said content”

is not a positive recitation that the cache does store the content. In response to appellant’s argument, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. As such, Rosser clearly teaches that the audio video storage unit 152, (col. 11, lines 1-8) may at least be embodied as RAM memory or a DVD, which are clearly capable of performing the intended use.

Answer 9. We do not agree that storing content in claim 47 is simply a statement of intended use. Any doubt that the recitation of “a cache . . . to store content” refers to a cache that actually stores content is removed by the further recitation of “a shell . . . to find a place to insert the advertisement *in the cached content before the cached content continues to be output* for display” (emphasis added). Therefore, in order to anticipate, Rosser must expressly or inherently disclose a cache that stores content and advertising.

The Examiner reads the recited “cache . . . storing content” on video/audio storage 152 in two different ways. First, the Examiner noted that because it can be in the form of a RAM (col. 11, ll. 1-4), it is inherently *capable* of storing both content and advertisements (Answer 9). However, as noted above, the claim

requires a cache (i.e., memory) that is described as intended to store content and advertising.

Second, the Examiner held that video/audio storage 152 is described as storing content and advertisements. Specifically, in the Final Action (at 3), the Examiner read the claimed cache on video/audio storage 152 (Fig. 4), citing passages in columns 13 and 14. The column 13 passage reads as follows:

One method of achieving this market segmentation by profile factor, is the following. While set-top central controller 146 is routing the viewer requested video, television or other source to the end user's set, it may also be routing alternate video or television feeds, either by different channels in the same down loader, or by different down-loader to video and audio storage unit 152 or data store 165. *This alternate video feed would typically be relaying a number of different advertisements with a requested viewer usage profile or range of profiles suitably associated, attached to or encoded in, each particular advertising sequence.* The contents of the alternative feed may be stored in video and audio storage unit 152. At the appropriate time and place for advertising insertion, which may be, but is not limited to, a conventional advertising break, or when the viewer changes channel, or when a particular image or scene is in view, the central controller will use video and audio router 150 and data router 152 and whichever is necessary of the other video and audio function modules, including but not limited to, video and audio storage device 152, to place an appropriate advertisement on the end user's viewing device 106. The appropriate advertisement on any given set top device would be the one where the local viewer usage profile matches or falls within the parameters of the required viewer usage profile attached to the advertisement.

Col. 13, ll. 13-37 (emphasis added). The Examiner construes the foregoing statement that “[t]his alternate video feed would typically be relaying a number of different advertisements” to mean that the alternate video feed is not limited to

advertising and thus may “atypically” include “content” (Answer 8-9). We agree with Appellant that “[t]here is no reason to know what is done ‘atypically’ because the reference does not say anything about such a hypothetical atypical operation” (Reply Br. 3). The use of the term “typically” does not necessarily imply that the alternate video feeds can contain content. That term can also be understood to mean that the advertising in the alternate video feed need not contain “a requested viewer usage profile or range of profiles suitably associated, attached to or encoded in, each particular advertising sequence,” as recited in the sentence in question. The column 13 passage is therefore at best ambiguous regarding whether video/audio storage 152 stores advertising and content and thus cannot be relied to prove anticipation. *See In re Brink*, 419 F.2d 914, 917 (CCPA 1970) (“if a reference is ambiguous and can be interpreted so that it may or may not constitute an anticipation of an appellant’s claims, an anticipation rejection under 35 U.S.C. § 102 based upon the ambiguous reference is improper”). Furthermore, Appellant correctly notes -- at least insofar as Rosser’s video/audio storage 152 is concerned -- that Rosser has “nothing to do with caching both advertisements and content. Instead, the reference believes that he does not need to cache content because he can somehow just inject the advertisements into the streaming [i.e., live] content.” Reply Br. 5.

Nor can support for the Examiner’s position be found in the cited column 14 passage, which reads:

The LVIS information extracted by interpreter 164, may be temporarily stored in e [sic] data store 168 for use at a later, appropriate time, or used immediately to extract appropriate material from data store 168, the video and audio storage unit 152, which may

be video and audio insertions, and direct it via the appropriate additional desk top functional units.

Col. 14, ll. 41-47. This passage does not indicate that either of data store 168 and video/audio storage 152 stores content other than advertisements and related information, such as required viewer usage profile information.

The Examiner alternatively relies on the fact that “Rosser discloses that the system may be used as a conventional VCR, see col. 5, lines 32-43, thereby storing conventional video programming” (Answer 9). The cited lines read as follows:

Writable digital video disks, or other high capacity, random access memory could be used by advertisers to store full motion video for insertion at the appropriate time. Such devices can also provide viewers with their own instant replay feature, automatically storing the last five or more minutes of what ever program was being watched. This feature would also make the magnification capability more compelling, especially for example to sports fans who may wish to go back and look at some aspect of play such as a ball landing close to a line in detail. Writable devices can also act as a scrap pad for grabbing bits of video they want to see later or show someone else; or as a more *conventional video recorder*.

Col. 5, ll. 31-42 (emphasis added). Appellant responded that

[t]he assertion that because Rosser teaches a VCR he could store anything, ignores the fact that the connections and arrangements of the RAM must be such to store content and advertisements. This Rosser never thought of. Plainly, there is no storage of both advertisements and content. That is part of what is wrong with Rosser from a technical standpoint. He simply does not store the content and thinks he can proceed without doing so.

Reply Br. 4. This argument is unpersuasive because it is based on the incorrect assumption that, in order to anticipate, Rosser must store both content and

advertisements in the video/audio storage 152 (which may be a RAM). Claim 47 is broad enough to permit the content and advertisements to be stored in different memories, as disclosed in Appellant's Specification (*e.g.*, at 5:9-11). Thus, Appellant has not shown that the Examiner erred in finding that Rosser discloses a cache that stores content as well as advertising.

The Examiner also relies on other parts of Rosser as disclosing caching content in addition to advertisements. Specifically, the Examiner held that "with respect to cached content, examiner contends that such a feature is broad enough to read on any temporary buffering or caching of the video during processing" (Answer 9), with the result that the claimed cached content can be read on either decompressor 82 or delay line 86 in Figure 2 (*id.* at 9-10). It is not clear whether the Examiner is proposing to (1) read both the cached content and the cached advertisement on these elements or (2) read only the cached content on those elements and read the cached advertisement on video insertion circuit 90 and/or text data circuit 92. The fact that the Examiner's explanation mentions video but not advertisements arguably can be understood to suggest that the Examiner was taking the second position, *i.e.*, reading only the cached content on either the decompressor or the delay line. However, because the Examiner's position is not clear on this point, we cannot fault Appellant for instead addressing only the other position. *See* Reply Br. 5 ("[T]o suggest that the MPEG standard requires storing both content and advertisements is, of course, ridiculous."). Because of the ambiguity in the Examiner's position, we will not affirm the rejection to the extent it relies on the decompressor and/or delay line.

Nevertheless, for the reason given above regarding “VCR” operation, Appellant has not persuaded us of error in the Examiner’s position that Rosser discloses “a cache . . . to store said content and said advertisement.”

C. Whether Rosser discloses the “update” limitations

The Examiner reads the recited “update instructions” on the “viewer usage profile keys” that are sent with the advertising information to identify the intended class of viewers and are compared with the viewer’s own usage profile (stored in the set-top device) in order to determine which advertising to display. Specifically, the Examiner held that

'update instructions' are broad enough to read on the LVIS information, such as information attached to a proposed insert, (col. 7, lines 1-19) which are sent from the headend and are used to determine which advertisement(s) will be inserted in the content, using the viewer usage profile data 120, col. 7, lines 45-58. Note, update instructions determine which Ad is shown. Also see Fig. 1 where two different Ads and logos are displayed based on the update instructions.

Answer 4. The Examiner further explained that

"update instructions" also reads on the instructions provided in the LVIS that change from one advertisement to another advertisement, such as user enabling key, usage profile keys, and program category code, see col. 7, lines 1-12; col. 7, lines 50-53 & col. 13, lines 25-48. These update instructions in Rosser, replace the default advertisement with an advertisement appropriate for the subscriber's set top box 44.

Answer 8. Of the these cited passages, the most relevant appears to be the following, which is part of Rosser’s discussion of using the Figure 4 embodiment to receive and store an alternate video feed that contains advertising video:

At the appropriate time and place for advertising insertion, which may be, but is not limited to, a conventional advertising break, or when the viewer changes channel, or when a particular image or scene is in view, the central controller will use video and audio router 150 and data router 152 and whichever is necessary of the other video and audio function modules, including but not limited to, video and audio storage device 152, to place an appropriate advertisement on the end user's viewing device 106. The appropriate advertisement on any given set top device would be the one where the local viewer usage profile matches or falls within the parameters of the required viewer usage profile attached to the advertisement. *A default advertisement may be shown to homes where the viewer profile does not match or fall within the profiles or profile ranges requested by the advertisers targeting their advertisements to specific audiences.*

Col. 13, ll. 25-37 (emphasis added).

While Appellant's assertion that "there is no default advertisement" (Reply Br. 3) is clearly incorrect, Appellant is correct to note that "the Examiner . . . never shows any language where anything is replaced with anything else" (*id.*). Rather than describing the replacement of a default advertisement with a different advertisement, the above-quoted passage simply explains that a default advertisement will be displayed in the absence of a match between the viewer's profile and the profiles required to view the other advertisements. Appellant is therefore correct to argue that "nowhere [in Rosser] is there the contemplation that advertisement in particular might need to be updated over time and thereby automatically replaced" (Appeal Br. 11).

We are accordingly reversing the rejection of claim 47 and its dependent claims 48-50 and 55-57 for anticipation by Rosser.

D. The obviousness rejection (claims 51-54)

Dependent claim 51, on which claims 52-54, depend, reads:

54. The system of claim 47 wherein said receiver to receive content interrupted with said advertisement, said receiver to determine whether said advertisement was previously stored.

The Examiner relied on Khoo for a teaching of providing a list of customized media to a user terminal, at least for the purpose of allowing the user to view the instant items that are stored and make modifications (Answer 6).

Because the subject matter relied on in Khoo does not cure the above-noted deficiencies in the rejection of parent claim 47 for anticipation by Rosser, the rejection of claims 51-54 for obviousness over Rosser in view of Khoo is also reversed.

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DECISION

The § 102 rejection of claims 47-50 and 55-57 is reversed, as is the § 103 rejection of claims 51-54.

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REVERSED

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